

REMARKS

The rejection of Claims 1, 2, 4, 7, and 9 under 35 U.S.C. §102(b) as being anticipated by Powell is respectfully traversed. Powell has a control box with a control panel (72) and display (76) but it does not comprise a table having number indicia for placing bets thereupon. There are no number indicia on the horizontal portion (24) of the control box's top surface (14) or the second portion (26) of the top surface which is angling downwardly, creating a sloped surface which would be unsuitable for placing bets thereupon if there were number indicia, as the bets would slide off. The surfaces of the control panel (72) and the display (76) are in the same plane as the sloped surface (26) (Figs. 1-3) and would likewise be unsuitable for placing bets thereupon. The control panel is described as having technology similar to a calculator or computer and having push buttons to facilitate its use "to program numbers that the user will guess as to be the winning lottery balls" (Col. 5, lines 19-24). If the push buttons have number indicia on them bets would not be placed thereupon, as not only would they slide off but they would interfere with the operation of the control panel for programming the numbers to be guessed, which are displayed on the display panel (Col. 5, lines 19-33). Powell lacks any description as to how the lottery game is played, other than to fill the need "for simulating a lottery ball action picking machine used in state lotteries" (Col. 1, lines 43-45). However, in such games a player typically buys a set of numbers. If the lottery selects the same numbers in the same sequence, the player wins. Any numbers displayed on the display panel would be separate numbers programmed from the control panel of numbers selected for a particular lottery with bets for that set of numbers, rather than on a particular number. In any event, the number indicia would not be for "placing bets thereupon" but would be a bet placed on that set of lottery numbers. Claim 1 is specific in that the number

indicia are for placing bets thereupon, meaning that bets are not just that particular numbers are being bet, but that the bets are actually placed on top of the numbers on the table. Being able to bet on numbers which may appear on a surface does not anticipate a table having number indicia for placing bets thereupon, particularly where the surface is sloped so the bets would slip off of the numbers once placed thereupon.

Additionally, Claim 1 has a display “for displaying the selected number” (singular), whereas Powell has a display for displaying the numbers (plural) the user guesses will be selected, (not the actual numbers selected) (Col 5, lines 19-33). And similarly, Claim 1 has a selector which produces a randomly selected number, the number being determinative of the game’s winning indicia, whereas Powell is used to select a set of lottery numbers, not just a single number to determine the winning indicia, and the likelihood of the selected numbers being the winning set is unlikely. A Powell player’s bet is for the opportunity to see if the dispensed balls match the selected and displayed numbers. Since only the winning numbers are displayed, and all of the other player selectable numbers are not displayed, there is no provision for placing bets upon player selectable numbers, i.e. Powell does not disclose a table with numbered indicia for placing bets thereupon. For these reasons Powell does not anticipate Claim 1.

The rejection of Claim 1 under 35 U.S.C. §102(e) as being anticipated by Perrie is respectfully traversed. Perrie has no number indicia for placing bets thereupon. All of the indicia of Perrie are alphabetical indicia or combinations of alphabetical and numeric indicia, but it lacks number indicia and therefore does not anticipate Claim 1. Also, the randomly selected number in Claim 1 is determinative of the game’s winning indicia, whereas in Perrie, the randomly selected

number is not necessarily determinative of the game's winning indicia. Also, Pierre does not disclose a table having number indicia for placing bets thereupon. For these reasons Pierre does not anticipate Claim 1. Pierre's wagering area 50 is a video touch screen; players place wagers by "touching the appropriate color group wager areas" on 50. See Col. 8, lines 11-14. So unlike Claim 1(a), wagering area 50 is not an area "for placing bets thereupon."

The rejection of Claims 3 and 8 under 35 U.S.C. §103(a) as being unpatentable over Powell is respectfully traversed. The remarks previously made above regarding Powell are applicable to this rejection and are incorporated herein as though set out in full. Additionally, with regard to Powell's lack of any provision for the placing of bets upon a table top, (Powell's control box is inclined and lacks number indicia) there is no motivation, teaching or suggestion to do so. As pointed out above, bets placed on the sloped surface (26) would just slide off. The examiner's suggestion that this could be done is the result of impermissible hindsight based on applicant's invention, since nothing contained in Powell discloses or even suggests such a feature. As for impermissible hindsight, the Federal Circuit Court of Appeals has ruled that:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner cited. In re Rouffet, Fed. Cir., No. 97-1492, 7/15/98 [BNA 56/1385 at 330]

Further, because there is no need or reason for Powell to have a table for the placing of bets on numbers thereupon, the examiner's suggestion that it would be obvious does not make it so absent Powell's suggestion that it would be desirable to do so.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In fact Powell teaches away from a table to place bets upon because he discloses only a sloped surface from which bets would slide off.

There is further reason that Powell does not disclose or suggest a table for placing bets thereupon and why there would be no incentive, motivation or reason for doing so. This is because bets on the control panel would cover the numbers displayed by 76 to the operator for comparison with the balls selected by the ball dispenser, and bets placed on the display would prevent such comparison, should they not slide off, and therefore interfere with the operation of the game. In sharp contrast, in applicant's invention all 38 numbers representing the numbers of a roulette wheel are displayed on the game table for the purpose of placing bets upon selected number indicia. The placing of a bet upon a number acts as a marker and the number selected can be easily determined from the other numbers adjacent to the marked number. For the above reasons, Powell does not teach or even suggest all limitations of the subject claims. For these reasons, Claims 3 and 8 are not made obvious by Powell.

The rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Kuhlman is respectfully traversed. The remarks previously made above regarding Powell

are applicable to this rejection and are incorporated herein as though set out in full. Powell does not teach all limitations of this claim, as previously described. Kuhlman uses a display screen for the game caller, not for all the players at a betting table which does not even exist in a Powell/Kuhlman combination. Furthermore there would be no incentive to combine Powell and Kuhlman because it is not clear how many players can participate in a Powell "lottery." If the panels 76 each display a single digit, then only one player can participate per game. If the panels 76 each contain multiple digit "lottery" numbers then only six can play at once. In short, Powell is designed for a very small player group, and so there would be no incentive to incorporate an expensive video camera and monitor setup such as Kuhlman's to display results. This is clearly the reason Powell chose not to include a results display.

Also with respect to Kuhlman, applicant traverses the examiner's comment that, "Examiner views such limitations to be commonly known in the art area." and requests that the examiner provide an affidavit, as called-for in the MPEP, section 2144.03 stating specifically all evidence, data and facts in support of his comment.

The rejection of Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Orselli is respectfully traversed. All the remarks previously made above regarding Powell are applicable to this rejection and are incorporated herein as though set out in full. Powell does not teach all limitations of this claim, as previously described. Further, there is no suggestion of the desirability of making the combination of Powell and Orselli, coupled with the examiner's own opinion that it would be obvious to exchange the "0" and "00" with "37" and "38".

As explained above, Powell is clearly limited as to the number of players, and it would make no sense to incorporate the expensive roulette setup of Orselli for such a small player group. Moreover Powell is designed to simulate a lottery which is a very different game from roulette. There would be no incentive to incorporate a roulette table and roulette indicia for a simple lottery game. As *In re Mills*, cited above, says: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Furthermore, there is nothing in Powell which would suggest the desirability of marking numbers 1-38 on its control panel which is clearly unsuitable for placing such indicia, and Orselli likewise has nothing to suggest the desirability of doing so for a simple lottery game. It is only the examiner's hindsight that even brings up such a suggestion. There is no motivation provided, only the examiner's statement that it would be a "choice of preference of the house." Applicant traverses the examiner's statement and requests he provide a declaration under MPEP section 2144.03 stating specifically all evidence, data and facts in support of his comment. Applicant is not a "house" and neither Powell or Orselli provide any such suggestion.

The rejection of Claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Levy is respectfully traversed. The remarks previously made above regarding Powell are applicable to this rejection and are incorporated herein as though set out in full. Powell does not teach all limitations of this claim, as previously described. Levy does not make Claims 10 or 11 obvious. In Levy the random number generator is a pair of dice rolled by a player at a table in a casino, the play received by closed circuit TV for a user making bets at a remote location. Levy does not control the random number generator. Applicant's invention


allows the user to control the activation of the random number generator. There is nothing in Levy which suggests or discloses the controlling of the random number generator. In fact, Levy specifically points out that the random number generator (the player rolling the dice) is disinterested and the possibilities of a rigged game are minimized (Col. 5, lines 19-26). For this reason Levy has no motive or teaching of the control of the random number generator. In fact, as noted Levy teaches away from any control of the random number generator. For these reasons Claims 10 and 11 are not made obvious by Powell and Levy.

The rejection of Claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Huard is respectfully traversed. The remarks previously made above regarding Powell are applicable to this rejection and are incorporated herein as though set out in full. Powell does not teach all limitations of this claim, as previously described. Huard does not make Claims 12 or 13 obvious. In Huard a device is used to pick a card at random using a mechanical card selection device, whereas applicant's invention uses a mechanical shuffler for arranging the cards in a random sequence prior to picking a card from the shuffled deck. While Huard also uses a computer to randomly pick a "magic card" from a virtual deck of cards, there is nothing to suggest or disclose the use of a mechanical shuffler for arranging the cards in a random sequence prior to picking a card from the shuffled deck. Furthermore, using cards as only a random number generator is not disclosed in the prior art, nor is it suggested by Huard. This is because cards require a great number of shuffles before their arrangement can be considered random. In fact it is an unknown as to how many shuffles are required for a true random sequence. Also the stickiness of the cards comes into play. Moreover the skill of the shuffler comes into play. A

poor shuffler could shuffle all day before achieving true randomness. This is very time consuming and would be impractical for use in a truly random number game. Additionally, while Huard discloses a display for a picked "magic card" from a virtual card deck as generated by the software in the computer, since this can be done without the use of a camera, there is nothing to suggest or disclose the displaying of a card or cards selected from a real card deck. Claims 12 and 13 are not made obvious by Powell or Huard.

It is believed the application is now in a condition for allowance, and reconsideration of this application is earnestly solicited.

Respectfully submitted,


Howard C. Tarr
Attorney for Applicant
Registration No. 29,449

Howard C. Tarr, Esq.
Tighe and Associates
6265 Greenwich Drive , Suite 103
San Diego, California 92122-5916
Telephone: (858) 450-1881
Facsimile: (858) 450-1898